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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,112	06/09/2000	Robert H. Hutchins, Jr.	HUTCP0101US	3415

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Paul R Steffes Esq  
Renner Otto Boisselle & Sklar  
1621 Euclid Avenue 19th Floor  
Cleveland, OH 44115

EXAMINER

MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 02/26/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

**Office Action Summary**

Application No.

09/591,112

Applicant(s)

HUTCHINS, JR., ROBERT H.

Examiner

Vishu K Mendiratta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 18-23, 25, 26, 28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-23, 25, 26, 28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Status: This is a request for continuing examination. Claims 1-15,18-23,25-26,28,30 are in the application.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-15 and 18-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the applicant is claiming "non-contiguous segments that are selectively moveable relative to one another". There is no disclosure of any such "non-contiguous segment that are selectively moveable relative to one another" at the time the application was filed.

Claims 2-15 and 18-22 are dependent from claim 1; as such they are all rejected accordingly.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-3, 5, 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Germanis (3,734,505).

Claim 1: Germanis teaches a game board assembly comprising a plurality of three-dimensional non-contiguous playing segments (reference character 1 in Fig.3) that are selectively moveable (see abstract line 4-6) relative to one another to define a rectilinear array (as can be seen from Fig.3), where the segments are spaced apart with rectilinear voids (examiner refers void area as the area around that is not covered when these segments/tiles are placed in area 5), one or more void fillers (4) disposed in voids (see col.2, lines 66-68). The void filler (4) has a thickness demonstrating the height of the wall (Fig.1).

Applicant may note that the intended use of the apparatus for playing chess does not further add any limitation to the apparatus in the claim.

Claim 2: Defining a segment as a playing space is considered as a rule for playing and does not add any limitation to the apparatus in the claim.

Claim 3: As can be seen in Fig. 3, segment/tile 1 has occupied at least more than one area (at least 4 areas are covered by similar segments).

Claim 5: Germanis teaches 100 playing segments that is more than 64 as in the claim (see col.2, lines 27-53).

Claim 9: Germanis demonstrates uniform spacing between segments (Fig.2)

Claim 10: Germanis teaches a three dimensional segment (1) having top wall (2), bottom wall (3) and column (see thickness of segment as shown in white in Fig.1) connecting top and bottom walls.

Claim 11: Germanis teaches segments in different patterns (see col.2, lines 16-17).

Claim 12: The examiner is interpreting the "interior region" as the central portion of the segment (1). Germanis demonstrates the segments (1) having an interior portion.

Claim 13: Examiner considers the segment/tile (1) big enough to receive playing pieces.

5. Claims 23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Eplett (4,696,476).

Claim 23: Eplett teaches a chess game playing assembly comprising a first (11) and opposite playing segment (14) disposed relative to each other (Fig.5) for playing a chess game. As also can be seen from Fig.5 the segments 11 and 14 demonstrate different topographical geometry, in that the two elevations are sloping in opposite directions. It can also be seen that the two segments have different motifs from each other, in that the patterns on top surfaces of squares of segment 11 do not match the motifs of corresponding top surfaces of segment 14.

Claim 26: Eplett demonstrates segments 11 and 14 disposed in opposite abutting relation in Fig.4.

6. Claims 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger (3,406,975).

Claim 28: Berger teaches a chess playing board having a first (1) and a second (4) playing segments defining 2 row by 8 column arrays, a third playing (col.1, lines 43-45) segment defining 4row by 8 column array.

Claim 30: Initial positioning of playing pieces pertains to rules for playing a game and do not further add any limitation to the structure of apparatus in the claim. However as can

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be seen Berger segments 1 and 4 have borders around three sides indicating these segments being opposite ends of a chess board where chess pieces are placed at the start of the game.

***Claim Rejections - 35 USC § 103***

7. Claims 4,6-8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Germanis in view of Bulbrook (GB 2229099A).

Claim 4: Germanis teaches all limitations of these claims except that it does not teach segments in different sizes.

Bulbrook uses a curved base for placing segments at various heights (Fig.2b) for raising some segments higher than others.

In order to simplify the arrangement while still having some segments higher than others, it would have been obvious to make some pieces taller than others.

One of ordinary skill in art at the time the invention was made would have modified

GERMANIS

Bulbrook to use segments in various sizes to make some segments stick out than others.

Claim 6-8: Germanis teaches all limitations of these claims except that it does not teach four corner segments higher than other segments and various elevations of segments in a sequence from higher to lower.

Bulbrook teaches four corner-segments higher than other segments (Fig.1), segments at different elevations (fig.1) in a sequence from higher to lower.

Bulbrook also teaches that such arrangement is known as resembling arena (page 1, line 30).

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In order to make the game aesthetically resemble an arena, it would have been obvious to place four corner segments at highest level, four innermost segments at lowest level and rest segments in between.

One of ordinary skill in art at the time the invention was made would have modified Germanis by placing segments at different levels to resemble an arena for aesthetical reasons.

Claim 18: Germanis teaches all limitations of these claims except that it does not teach a chess setup of 8 row by 8 column.

Bulbrook teaches segments set up in a chess arrangement of 8 by 8(Fig.1).

In order to play a chess game it would have been obvious to set up segments in a chess arrangement. One of ordinary skill in art at the time the invention was made would have 8 by 8 arrangement for playing a chess game.

8. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Germanis in view of Gaito (5,462,281).

Germanis teaches all limitations of these claims except that it does not teach light in the segment and it being transparent/translucent.

Gaito teaches interior of segments having light bulbs (50,52) and translucent window (46)

In order to make the playing positions illuminated, it would have been obvious to provide electric bulbs in the interior of the segments surrounded by transparent/translucent walls.

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One of ordinary skill in art at the time the invention was made would have provided a bulb in the interior of the segments for illuminating purposes.

9. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Germanis in view of Hullinger (6,279,907).

Germanis teaches all limitations of these claims except that it does not teach implementation of the game on computer.

Hullinger teaches implementation of such a game having segments on computer and use of software (Abstract).

In order to popularize the game, it would have been obvious to implement the game on computer.

One of ordinary skill in art at the time the invention was made would have implemented the game on computer for large number of people to access the game.

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eplett in view of Post (2,946,592).

Eplett teaches four segments collectively making an 8 by 8 formation for storing the game in a significantly small space.

Eplett does not teach two 4 by 8 collectively forming 8 by 8 formation.

Post teaches game formation with two 4 by 8 segments (10,12).

Providing a larger space for storing the game, it would have been obvious to make the game in lesser number of segments. One of ordinary skill in art at the time the invention was made would have used only two 4 by 8 segments to make the game.



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***Response to Arguments***

11. Applicant's arguments with respect to claims 1-15,18-22,25,28,30 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed 10/7/02 (paper #8) have been fully considered but they are not persuasive. Applicant argues that Eplett does not disclose differing topographic geometries as in amended claim 23. Examiner takes the position that segment 11 and 14 slope downward in opposite directions when placed side by side, in that they differ in topographic geometries. Applicant lacks arguments towards rejection of claim 26.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Seligman (1,578,554) teaches selectively movable segments (9) and void fillers (13). Matsumoto teaches moveable segments (18) and void fillers (14) since applicant is not claiming moveable void fillers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number is (703) 306-5695. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T. Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Vishu K Mendiratta  
Examiner  
Art Unit 3711

VKM  
February 13, 2003